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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/336,706	06/21/1999	SUMIYO OKADA	21.1924/JRB	7969

21171 7590 10/25/2005

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EXAMINER

PRIETO, BEATRIZ

ART UNIT PAPER NUMBER

2142

DATE MAILED: 10/25/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 09/336,706	Applicant(s) OKADA ET AL.	
	Examiner Prieto B.	Art Unit 2142	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 03 October 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-3 and 13-36 is/are pending in the application.
- 4a) Of the above claim(s) 13-15 and 18-25 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☐ Claim(s) _____ is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 21 June 1999 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. This communication is in response to Amendment filed 10/03/05, claims 1-2, 31 have been amended and claim 36 has been added, claims 13-15 and 18-25 remain withdrawn from consideration, claims 4-12 have been canceled.

2. Regarding added claim limitations, i.e. “requesting and obtaining cooperation from the two chat networks for display of message of the two chat networks”. There is a strong presumption that an adequate written description of the claimed invention is present in the specification as filed, Wertheim, 541 F.2d at 262, 191 USPQ at 96; however, with respect to newly added or amended claims, applicant should show support in the original disclosure for the new or amended claims. See MPEP § 714.02, and 2163.06. (“Applicant should specifically point out the support for any amendments made to the disclosure.”) (see MPEP § 2163 B (II)).

3. Regarding added claim limitations, i.e. “*requesting and obtaining cooperation from the two chat networks for display of message of the two chat networks*”. And further, regarding new added claim limitation, “*requesting and obtaining cooperation from the two chat networks for display of messages of the two chat networks to automatically extend as display path for the messages and displaying, with the client, the obtained message in a first discrete display area using extended display path*”.

It is respectfully noted that, the meaning of every term used in any of the claims should be apparent from the descriptive portion of the specification with clear disclosure as to its import; and in mechanical cases, it should be identified in the descriptive portion of the specification by reference to the drawing, designating the part or parts therein to which the term applies. A term used in the claims may be given a special meaning in the description. No term may be given a meaning repugnant to the usual meaning of the term. Usually the terminology of the original claims follows the nomenclature of the specification, but sometimes in amending the claims or in adding new claims, new terms are introduced that do not appear in the specification. The use of a confusing variety of terms for the same thing should not be permitted.

While an applicant is not limited to the nomenclature used in the application as filed, he or she should make appropriate amendment of the specification whenever this nomenclature is departed from by amendment of the claims so as to have clear support or antecedent basis in the specification for the new terms appearing in the claims. This is necessary in order to insure certainty in construing the claims

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in the light of the specification, *Ex parte Kotler*, 1901 C.D. 62, 95 O.G. 2684 (Comm'r Pat. 1901). See 37 CFR 1.75, MPEP § 608.01(i) and § 1302.01. (see **MPEP 608.01(o)**)

4. Applicant is required to provide clear support or antecedent basis for the terms appearing in the claims. Specifically, the added limitations noted on item 3 above. No new matter shall be introduced. Applicant should show support in the original disclosure for the new or amended claims. See MPEP § 714.02, and 2163.06. ("Applicant should specifically point out the support for any amendments made to the disclosure.") (see MPEP § 2163 B (II)).

All amendments or claims must find descriptive basis in the original disclosure, or they involve new matter. Applicant may rely for disclosure upon the specification with original claims and drawings, as filed (see 37 CFR 1.121(f) and **MPEP § 608.04**).

5. Regarding claim clause "a chat network is designated as current designation", the clause lacks written disclosure in the specification of instant invention, i.e. NOT clearly having support or antecedent basis in the specification, as previously noted.

Therefore, [*as best understood*] and broadly interpreted in light of the disclosure, the claim (1, 26, 27 and 34) clause, "*a chat network is designated as current designation*", will be interpreted as "inputting an instruction (i.e. designating) to a chat network for a channel communication".

6. Regarding claimed term "chat network", there is an explicit definition set forth in the invention's disclosure and therefore, in accordance with MPEP §2106, where an explicit definition is provided by the applicant for a term, *that definition will control interpretation* of the term as it is used in the claim. *Toro Co. v. White Consolidated Industries Inc.*, 199 F.3d 1295, 1301, 53 USPQ2d 1065, 1069 (Fed. Cir. 1999).

The definition set forth by the invention in its disclosure is clear, and explicit. The definition presented in exemplified form, which as best understood, simply means that they are other definitions, it does not preclude nor exclude this definition from being adopted when interpreting the claims.

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Prieto, B. whose telephone number is (571) 272-3902. The Examiner can normally be reached on Monday-Friday from 6:00 to 3:30 p.m. If attempts to reach the examiner by telephone are unsuccessful, the Examiner's Supervisor, Andrew T. Caldwell can be reached at (571) 272-3868. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 305-3800/4700.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system, status information for published application may be obtained from either Private or Public PAIR, for unpublished application Private PAIR only (see <http://pair-direct.uspto.gov> or the Electronic Business Center at 866-217-9197 (toll-free).

Any response to this action should be mailed to:

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Hand carried or delivered to:

Customer Service Window located at the Randolph Bldg.
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Faxed to the Central Fax Office:

(703) 872-9306 (old No. in service until Sept. 15, 2005),
(571) 273-8300 (New Central Fax No.)

Or Telephone:

(703) 306-5631 for TC 2100 Customer Service Office.

B. Prieto
Primary Examiner
TC 2100
October 21, 2005


BEATRIZ PRIETO
PRIMARY EXAMINER